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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,332	11/06/2003	Ezequiel Romo	P1484CIP	7922

8968 7590 11/03/2005

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EXAMINER .

PRONE, JASON D

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/702,332	ROMO ET AL.	
	Examiner	Art Unit	
	Jason Prone	3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 1-13, 22 and 28 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14, 17, 18, 20 and 23 is/are allowed.
- 6) ☒ Claim(s) 15, 16, 25-27 and 29 is/are rejected.
- 7) ☒ Claim(s) 19, 21 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/5/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

It is noted that claims 1-13 are the only claims disclosing limitation disclosed in the parent case 10/135,299 and, therefore, are the only claims to receive the filing date of 30 April 2002. Claims 14-29 disclose limitations not disclosed in the parent case 10/135,299 and, therefore, receive the filing date of 06 November 2003. The reference to Romo 2003/0200852 A1 is prior art in regards to claims 14-29 only.

Election/Restrictions

1. Applicant's election with traverse of Species B in the reply filed on 21 March 2005 is acknowledged
2. Claims 1-13, 22, and 28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 21 March 2005. In the original Office action dated 18 May 2005, independent claims 1 and 7 were considered generic to both species. The limitations "a yoke with opposed side walls separated by a distance" and "an insert located between the sidewalls" were considered, at the time of the original Office action, to be present in both species. Using Figure 15 of the elected species, items "533" and "535" were considered the side walls of the yoke and item "514" was the insert located between the sidewalls. However, in the original specification, applicant was silent as to what structure was actually the yoke. It was assumed that the term "yoke" was referring to items "533" and "535" and the word "yoke" was used as a generic term to allow the claim to represent both species. In the response dated 22 August 2005, applicant

provided an amendment to the specification and to the drawings specifically labeling the yoke of the elected species as item "320" making the examiners assumption of items "533" and "535" as the yoke incorrect. There is no support in the Figures or the specification that yoke "320" incorporates two spaced apart sidewalls capable of locating an insert therebetween. Using replacement Figure 16, the insert 310 appears to be sandwiched between the lever "220" and Yoke "320". From the Figures, yoke "320" is only a single plate and the specification's lack of description fails to prove otherwise. Also, yoke "320" does not interact with insert "514". In view of the recently presented evidence that item "320" represents the yoke and not items "533" and "535", claims 1-13 are withdrawn from prosecution.

It is also noted that the original species election identified two separate species A (Figs. 1-8) and B (Figs. 9-20). Claims 14 and 27 clearly disclose limitations only belonging to elected species B. The only reason to withdrawn claims is the fact that they are limitations belonging only to non-elected species A. That being said, independent claims 14 and 27 refer to species B only how can claims 14 and 27 have a claim (22 and 28) depending off of them that belongs to species A only. If claims 22 and 28 were to be rejoined a new matter rejection would come about.

Claim Objections

3. Claims 19, 21, and 24 are objected to because of the following informalities: In regards to claim 19, the phrase "wherein movement of the insert results" should be replaced with "wherein movement of the first or second insert results". Even though both inserts do move, the generic term "inserts" could cause some confusion due to

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there being two separate inserts. In regards to claim 21, the phrase "worktable" should be replaced with "turntable" for consistency. In regards to claim 24, the phrase "second insert" should be replaced with "insert". There is not a first insert so there cannot be a second insert. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 15, 16, 25, and 26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

On page 13 lines 6-9 of paragraph [0064], the phrase "movement of the fine-adjustment lever 510 is caused by applying pressure to the lever 510, which causes the latch 522 to press against the spring 518 in the latch holder 516, thereby causing the protrusions 524 on the latch 522 to recess from within the notches 512 on the lever 510" is unclear. Using Figures 11, 14, and 15, it is uncertain how the pressure applied to move lever 510 allows latch 522 to press against spring 518. If the pressure applied to the lever is a horizontal force, it is unclear how that force allows latch 522 to move in a vertical direction. On lines 3-4 of paragraph [0066], the phrase "The repress plate 526 holds the fine-adjustment lever 510 in contact with the latch protrusions 524 and thus restricts the movement of the fine-adjustment lever 510" states that plate holds lever

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510 and protrusion 524 together. Figure 11 appears to have plate 526 in place but yet it still shows movement of the lever. Basically, with plate 526 keeping the lever and the protrusion intact to restrict movement, how can the lever move and force the protrusion to withdraw from the lever with plate 526 connected to the assembly.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 27 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Romo (2003/0200852)

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. In this case, the instant application is a continuation in part, of 10/135,299, which features 2 embodiments. The second/elected embodiment is not featured in the parent case 10/135,299. The parent case also has a different inventive entity than the child case.

Basically, the new/elected embodiment is not disclosed in the parent and, therefore, does not receive the filing date from the parent. Also, the specific limitation of "a second means for finely adjusting the angular relation of the turntable relative to the base within about $\pm 2\frac{1}{2}^\circ$ " is assumed to have been invented by the additional inventor not included in the parent case.

In regards to claim 27, Romo discloses the same invention including a base (200) having a means for defining a reference angle with respect to the base (95), a turntable rotatably mounted to a base (30), the turntable supports the cutting tool (Abstract), a first means for angularly adjusting the turntable relative to the base (32), a second means for finely adjusting the angular relation of the turntable relative to the base within about $\pm 2\frac{1}{2}^\circ$ (190).

In regards to claim 29, Romo discloses the first means is a first insert (32, Fig. 1 clearly shows item 32 is being inserted into item 15 and held into place by item 60, making item 32 an insert) and the second means includes a second insert adapted to move along an axis tangential to a radius of curvature of the turntable (110).

The parent case does not disclose the exact range, so one can only speculate that the fine adjustment of the parent case could in fact go as far as $-2\frac{1}{2}^\circ$ or $+2\frac{1}{2}^\circ$, however, all that is being claimed is that the angular relation is adjusted within about $\pm 2\frac{1}{2}^\circ$. Therefore, the parent case is capable of being fine adjusted within the range because it is capable of being fine adjusted to a degrees represented by the smallest possible turn which would fall into the disclosed range. Also, 0° falls within the range, so, technically, no fine adjustment at all could meet the limitation.

Allowable Subject Matter

8. Claims 14, 17, 18, 20, and 23 are allowed. Claim 14 is considered to disclose the following allowable subject matter: the combination of an angular adjustment pivotally mounted to the turntable with a first insert and a fine-adjustment lever pivotally mounted to the turntable supporting a second insert.

9. Claims 19, 21, and 24 would be allowable if rewritten or amended to overcome the objection(s), set forth in this Office action.

10. Claims 15, 16, 25, and 26 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action.

Response to Arguments

11. Applicant's arguments with respect to claims 1-13 have been considered and were persuasive but these claims were withdrawn (see paragraph 2 above). Applicant failed to address/comment on the rejection regarding 112 1st paragraph, therefore, the rejection remains.

12. It is also noted that the non-elected species is the exact same structure as the apparatus disclosed in the parent case. The parent case 10/135,299 had only a single inventor. If the withdrawn claims were to be reinstated, a 102(f) rejection would arise due to the instant application incorporating an additional inventor.

Conclusion

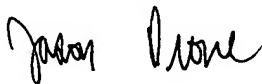
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is (571) 272-4513. The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

October 27, 2005



Patent Examiner
Jason Prone
Art Unit 3724
T.C. 3700